

#3

PTO/SB/01 (10-01)

Approved for use through 10/31/2002. OMB 0651-0032

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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**DECLARATION FOR UTILITY OR  
DESIGN  
PATENT APPLICATION  
(37 CFR 1.63)**

☐ Declaration Submitted with Initial Filing

OR

☒ Declaration Submitted after Initial Filing (surcharge (37 CFR 1.16 (e)) required)

|                          |                    |
|--------------------------|--------------------|
| Attorney Docket Number   | 096/004            |
| First Named Inventor     | Jim McWhir, et al. |
| <b>COMPLETE IF KNOWN</b> |                    |
| Application Number       | 09 / 995,419       |
| Filing Date              | November 26, 2001  |
| Art Unit                 | 1636               |
| Examiner Name            | [to be assigned]   |

As the below named inventor, I hereby declare that:

My residence, mailing address, and citizenship are as stated below next to my name.

I believe I am the original and first inventor of the subject matter which is claimed and for which a patent is sought on the invention entitled:



Selective Antibody Targeting of Undifferentiated Stem Cells

(Title of the Invention)

the specification of which

☐ is attached hereto

OR

☒ was filed on (MM/DD/YYYY) **November 26, 2001** as United States Application Number or PCT InternationalApplication Number **09/995,419** and was amended on (MM/DD/YYYY) (if applicable).

I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment specifically referred to above.

I acknowledge the duty to disclose information which is material to patentability as defined in 37 CFR 1.56, including for continuation-in-part applications, material information which became available between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application.

I hereby claim foreign priority benefits under 35 U.S.C. 119(a)-(d) or (f), or 365(b) of any foreign application(s) for patent, inventor's or plant breeder's rights certificate(s), or 365(a) of any PCT international application which designated at least one country other than the United States of America, listed below and have also identified below, by checking the box, any foreign application for patent, inventor's or plant breeder's rights certificate(s), or any PCT international application having a filing date before that of the application on which priority is claimed.

| Prior Foreign Application Number(s) | Country | Foreign Filing Date (MM/DD/YYYY) | Priority Not Claimed     | Certified Copy Attached? |                          |
|-------------------------------------|---------|----------------------------------|--------------------------|--------------------------|--------------------------|
|                                     |         |                                  |                          | YES                      | NO                       |
|                                     |         |                                  | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> |
|                                     |         |                                  | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> |
|                                     |         |                                  | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> |
|                                     |         |                                  | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> |

☐ Additional foreign application numbers are listed on a supplemental priority data sheet PTO/SB/02B attached hereto:

[Page 1 of 3]

Burden Hour Statement: This form is estimated to take 21 minutes to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

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**DECLARATION — Utility or Design Patent Application**Direct all correspondence to: ☒Customer Number  
or Bar Code LabelOR ☐

Correspondence address below

22869

PATENT TRADEMARK OFFICE

Name

Address

City

State

ZIP

Country

Telephone

Fax

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001 and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

NAME OF SOLE OR FIRST INVENTOR :



A petition has been filed for this unsigned inventor

Given Name

Jim

Family Name

McWhir

(first and middle [if any])

or Surname

Inventor's  
Signature

Date

15/02/02

Residence: City

Midlothian

State

Scotland

Country

UK

Citizenship

UK

Mailing Address

City

Midlothian

State

Scotland

ZIP

EH25 9PS

Country

UK

NAME OF SECOND INVENTOR:



A petition has been filed for this unsigned inventor

Given Name

Joseph D.

Family Name

Gold

(first and middle [if any])

or Surname

Inventor's  
Signature

Date

21/02

Residence: City

San Francisco

State

California

Country

US

Citizenship

US

Mailing Address

100 Lundy's Lane

City

San Francisco

State

California

ZIP

94110

Country

US

☒ Additional inventor is being named on the 1 supplemental Additional Inventor sheet PTO/SB/02A attached hereto.

Please type a plus sign (+) inside this box → ☐

PTO/SB/02A (11-00)

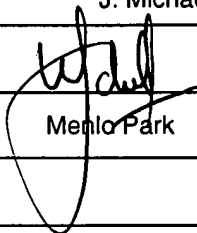
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## DECLARATION

**ADDITIONAL INVENTOR(S)**  
**Supplemental Sheet**  
Page 3 of 3

|   |            |   |            |
|---|------------|---|------------|
| <b>Name of Additional Joint Inventor, if any:</b>   |            | <input type="checkbox"/> A petition has been filed for this unsigned inventor |            |
| Given Name (first and middle [if any])  |            | Family Name or Surname  |            |
| J. Michael  |            | Schiff  |            |
| Inventor's Signature<br> |            | February 1, 2002<br>Date  |            |
| Residence: City   | Menlo Park | State   | California |
|   |            | Country   | US         |
| Citizenship CA  |            |   |            |
| Mailing Address   |            |   |            |
| Mailing Address   |            |   |            |
| City  | Menlo Park | State   | California |
|   |            | ZIP   | 94025      |
|   |            | Country   | US         |
| <b>Name of Additional Joint Inventor, if any:</b>   |            | <input type="checkbox"/> A petition has been filed for this unsigned inventor |            |
| Given Name (first and middle [if any])  |            | Family Name or Surname  |            |
|   |            |   |            |
| Inventor's Signature  |            | Date  |            |
| Residence: City   |            | State   |            |
|   |            | Country   |            |
| Citizenship   |            |   |            |
| Mailing Address   |            |   |            |
| Mailing Address   |            |   |            |
| City  |            | State   |            |
|   |            | ZIP   |            |
|   |            | Country   |            |
| <b>Name of Additional Joint Inventor, if any:</b>   |            | <input type="checkbox"/> A petition has been filed for this unsigned inventor |            |
| Given Name (first and middle [if any])  |            | Family Name or Surname  |            |
|   |            |   |            |
| Inventor's Signature  |            | Date  |            |
| Residence: City   |            | State   |            |
|   |            | Country   |            |
| Citizenship   |            |   |            |
| Mailing Address   |            |   |            |
| Mailing Address   |            |   |            |
| City  |            | State   |            |
|   |            | ZIP   |            |
|   |            | Country   |            |

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STATEMENT UNDER 37 CFR 3.73(b)

Applicant/Patent Owner: Geron Corporation

Application No./Patent No.: 09/995,419

Filing Date: November 26, 2001

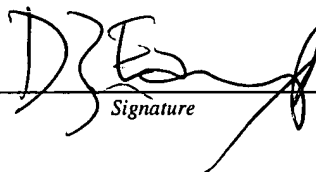
Entitled: SELECTIVE ANTIBODY TARGETING OF UNDIFFERENTIATED STEM CELLS

**GERON CORPORATION**, a corporation, states that it is an assignee of the entire right, title, and interest in the patent application/patent identified above by virtue of:

An assignment from the inventors of the above-referenced patent application, a true copy of which is attached hereto.

The undersigned (whose title is supplied below) is empowered to sign this statement on behalf of the assignee.

FEB 25, 2002  
Date

  
Signature

David J. Earp, Reg. No. 41,401  
Typed or printed name

Vice President, Intellectual Property  
Title



ASSIGNATION

COPY

This is an assignment by Biotechnology and Biological Sciences Research Council, whose principal office is at Polaris House, North Star Avenue, Swindon SN2 1UH, England ("BBSRC") and Dr. Jim McWhir of Midlothian, Scotland ("the Inventor") in favor of the Roslin Institute (Edinburgh) of Roslin Biotechnology Centre, Roslin, Midlothian EH25 9PS, Scotland ("the Institute"). Collectively, the BBSRC and the Inventor are hereby referred to as the ASSIGNORS.

WHEREAS:

- (A) The Inventor, along with co-inventors Joseph D. Gold and J. Michael Schiff, has created certain new and useful improvements directed towards methods for removing undifferentiated cells from cell populations, such inventions being described in the following patent application:

| <i>Patent Application No.</i> | <i>Title</i>  | <i>Filing Date</i> |
|-------------------------------|---|--------------------|
| 09/995,419                    | Selective Antibody Targeting of Undifferentiated Stem Cells | 26 November 2001   |

- (B) Said inventions were created by the Inventor in his capacity as an employee of the BBSRC based at the Roslin Institute and in circumstances such that the Inventor's rights to the Inventions belong ab initio to the BBSRC by virtue of the provisions of the UK Patents Act 1977.
- (C) Pursuant to an Agreement entitled "Conditions of Grant and Agreement Transferring Ownership of Intellectual Property" dated January, 2000 between the BBSRC and the Institute, ownership of intellectual property rights generated at the Institute over a three year period through December 31, 2002 is transferred from the BBSRC to the Institute.
- (D) The inventions were created in the course of a research project funded by Geron pursuant to a Research and License Agreement entered into between the Institute, Geron and Geron Bio-Med Limited dated 30<sup>th</sup> April and 3<sup>rd</sup> May 1999 ("the Research Agreements").

NOW THEREFORE IT IS AGREED AS FOLLOWS:

1. DEFINITIONS

In this Assignment (including the Recitals) unless the context otherwise requires:

**Invention** means the invention relating to methods for removing undifferentiated cells from cell populations which is the subject of the U.S. Patent Application Serial No. 09/995,419;

**Intellectual Property Rights** means all present and future and other relevant intellectual property rights relating to the Invention, and all applications and rights to apply for registration of such rights anywhere in the world and the right to sue for any and all past infringements of such rights;

**Patent Application** means the United States Patent Application Serial No. 09/995,419.

2. **ASSIGNATION**

The BBSRC and the Inventor by the execution of this Assignment, hereby assign to Roslin Institute (the Assignee), all of his property, right, title, and interest in and to the Invention, the Patent Applications and the Intellectual Property Rights, including all statutory and common law rights.

The rights of the other co-inventors shall be separately assigned to Geron Corporation.

3. **UNDERTAKING**

Each of the Assignors hereby irrevocably undertake at the request and cost of the Assignee to do and execute all such further documents, forms and authorisations as may be required to vest its full property, right, title and interest in and to the Inventions, the Patent Applications and any other Intellectual Property Rights in the Assignee absolutely, including but not limited to registration of the Assignee's title as proprietor at relevant patent offices and trade mark registries anywhere in the world and, for this purpose, each of the Assignors hereby irrevocably appoints the Assignee to act as their attorney with the power to do and execute any such documents, forms and authorizations on their behalf.

4. **GOVERNING LAW**

This Assignment shall be governed by and construed in accordance with the laws of Scotland and the parties hereby prorogate the exclusive jurisdiction of the Scottish Courts: **IN WITNESS WHEREOF** these presents on this and the preceding page are executed as follows:

SUBSCRIBED for and on behalf of  
BIOTECHNOLOGY AND BIOLOGICAL  
SCIENCES RESEARCH COUNCIL by

Authorised Signatory, at *London*  
on *21 February* 2002 before the  
following Witness:

*[Signature]* ..... Witness  
*JOHN WITHERS* ..... Full Name  
*SALTIRE COTTAGE* ..... Address  
*ATHOL STREET, EDINBURGH* ..... Address

*[Signature]* .....  
For and on behalf of Biotechnology and  
Biological Sciences Research Council

SUBSCRIBED for and on behalf of ROSLIN  
INSTITUTE (EDINBURGH) by

Authorised Signatory, at *Roslin*  
on *22 February* 2002  
before the following Witness:

..... Witness  
..... Full Name  
..... Address  
.....

*[Signature]* .....  
For and on behalf of Roslin Institute  
(Edinburgh)

SIGNED by Jim McWhir at  
on *19/02/02* 2002  
before the following Witness:

*[Signature]* ..... Witness  
*FRANCES BURGESS* ..... Full Name  
*8 SKELTUMVIR AVE* ..... Address  
*BONNY RICK* ..... Address

*[Signature]* .....  
Jim McWhir

SUBSCRIBED for and on behalf of GERON  
BIO-MED LIMITED by

Authorised Signatory, at  
on 19th February  
before the following Witness:

2002

B. R. H.  
For and on behalf of Geron Bio-Med Limited

J. Yang..... Witness  
Jacqueline Yang..... Full Name  
5 Muirpark, Estbank..... Address  
Durham E.H.22.3JG.

SUBSCRIBED for and on behalf of GERON  
CORPORATION by

Authorised Signatory, at MEMO PARK, CALIFORNIA  
on FEB. 25  
before the following Witness:

2002

D. E.  
For and on behalf of Geron Corporation

Markusky..... Witness  
DAVID MARKUSKY..... Full Name  
230 Constitution Dr...... Address  
Menlo Park, Ca 94025





ASSIGNMENT

COPY

Whereas we, Joseph D. Gold and J. Michael Schiff

executed employment agreements with Geron Corporation (hereinafter called Geron), a Delaware Corporation having its principal place of business at 230 Constitution Drive, Menlo Park, CA 94025, whereby we have agreed to assign to Geron all inventions (except as otherwise limited by law) which relate to Geron business and which were first conceived or actually reduced to practice during our employment by Geron;

Now, therefor, pursuant to the terms of said employment agreements and for good and valuable consideration, receipt of which is hereby acknowledged, we do hereby sell, assign and transfer unto Geron, its successors and assigns, the entire right, title and interest, including the right of priority in, to and under an application for Letters Patent of the United States entitled:

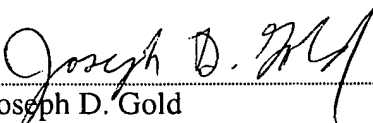
SELECTIVE ANTIBODY TARGETING OF UNDIFFERENTIATED STEM CELLS

[X] Serial No. 09/995,419 filed on 26 November 2001 and the inventions set forth and described therein, and any and all Letters Patent of the United States and of countries foreign thereto which may be granted thereon or therefor;

And for the above consideration, we agree promptly upon request of Geron, its successors or assigns, to execute and deliver without further compensation any power of attorney, assignment, application, whether original, continuation, divisional or reissue, or other papers which may be necessary or desirable fully to secure to Geron, its successors and assigns, the inventions described in said application and all patent rights therein, in the United States and in any country foreign thereto, and to cooperate and assist in the prosecution of interference proceedings involving said inventions and in the adjudication or reexamination of said Letters Patent provided the expenses which may be incurred by me in lending such cooperation and assistance are paid by Geron.

In witness whereof, we hereunto set our hands and seal:

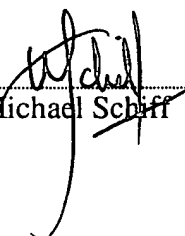
Inventor's  
Signature:

  
Joseph D. Gold

Date:

1/31/02

Inventor's  
Signature:

  
J. Michael Schiff

Date:

February 1, 2002

State of California

} ss.

County of San Mateo

Before me this 31<sup>st</sup> day of January 2002 personally appeared  
Joseph D. Gold personally known to me (or proved to me on the basis of satisfactory evidence)  
to be the person whose name is subscribed to the foregoing instrument and acknowledged to me that he/she executed  
the same in his/her authorized capacity, and that by his/her signature on the instrument the person executed the  
instrument.



Notary Stamp/Seal

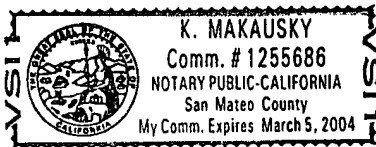
K. Makusky  
Notary Public

State of California

} ss.

County of San Mateo

Before me this 1<sup>st</sup> day of February 2002 personally appeared  
J. Michael Schiff personally known to me (or proved to me on the basis of satisfactory evidence)  
to be the person whose name is subscribed to the foregoing instrument and acknowledged to me that he/she executed  
the same in his/her authorized capacity, and that by his/her signature on the instrument the person executed the  
instrument.



Notary Stamp/Seal

K. Makusky  
Notary Public